

REMARKS/ARGUMENTS

As filed, the application included claims 1-20. An Office Action mailed January 18, 2006, rejected claims 1, 2 and 4-20 under 35 U.S.C. § 102(e) as being anticipated by US Patent No. 6,859,806 to Kamarei et al. ("Kamarei"). The Office Action also rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Kamarei.

This amendment amends claims 1, 11, 12, 16 and 17 cancels claim 4 and adds claims 21-26. Hence, after entry of this amendment, claims 1-3 and 5-26 stand pending for examination.

Claim Amendments

Claim 1 has been amended to incorporate an element similar to that recited by original claim 4, and claim 4 has been canceled accordingly. Claims 11 and 17 has been amended in similar fashion, while claim 16 has been amended to remove the term "data related to" from the phrase "data related to one or more documents" to more clearly specify the nature of the claimed invention. Claim 12 has been amended to eliminate an element that is redundant in light of the amendment of claim 11.

New claims 21-26 have been added. Support for the new claims can be found throughout the application, including specifically in paragraphs [51] and [62]-[65].

§ 102 Rejections

Claims 1, 2 and 5-20 were rejected under § 102(e) as being anticipated by Kamarei. These rejections are respectfully traversed, because Kamarei fails to teach or suggest each element of any of the rejected claims. Take, for example, amended claim 1, which recites, inter alia, "wherein storing information related to the first intellectual property case comprises storing the information related to the first intellectual property case in a case data unit, wherein the case data unit stores data related to the first intellectual property case and one or more documents related to the first intellectual property case." Kamarei fails to teach or suggest at least this element. For instance, Kamarei fails to teach a case data unit that stores one or more

documents related to an intellectual property case. Instead, Kamarei merely teaches the storage of docketing information, along with triggering associated reminders and deadlines. Merely storing docketing information

The office action cites Fig. 6, as well as column 8, line 45 through column 9, line 2, and column 9, line 32 through column 10, line 9 as teaching the storage of documents related to an intellectual property case. None of those passages provide such a teaching, however. Fig. 6 merely illustrates a screen showing “a default Client Rules Subset 42.” Kamarei, c. 9, ll. 4-5. The Client Rules Subset is described thusly: “Each default Client Rules Subset preferably has Pattern Data 44 relating to a particular legal field, such as patent prosecution, trademark prosecution or litigation, an Action Prompt 30 associated with the Pattern Data and Time Calculus 46.” *Id.*, c. 9, ll. 6-10.

The office action apparently interprets the Action Prompt of Kamarei as teaching the storage of documents associated with an intellectual property case. A close reading of Kamarei, however, reveals that this is not the case. As Kamarei discloses, “[t]he Action Prompt 30 and Action Prompt Due Date (Not shown) provide the vehicle for notifying users of a Client System of the type of action that needs to be taken in the governmental proceeding and the time that such action should be taken, or a reminder in advance of the time an action should be taken.” *Id.*, c. 9, ll. 32-37. Clearly, the Action Prompt is merely a reminder system and has nothing to do with the storage of documents. Moreover, nothing else in the cited passages (which merely describes the functioning of the Action Prompt) teaches or suggests storing any documents related to an intellectual property case.

For at least this reason, claim 1 is believed to be allowable over Kamarei, and reconsideration of the rejection is respectfully requested. Independent claims 11 and 17 recite similar elements to those described above and therefore are considered to be allowable as well. Claim 16 recites “a storage module configured to store . . . one or more documents related to the intellectual property case.” As noted above, Kamarei fails to teach or suggest such document storage, and claim 16 therefore is believed to be allowable over Kamarei as well.

New claims 21-26 are further define the invention of claim 1, and they provide examples that highlight the failings of Kamarei's disclosure in that regard. In addition, claims 21-26 are believed to be independently allowable based on their additional recitations. For example, claim 21 recites various types of documents that can be stored in a case data unit. Since Kamarei fails to teach or suggest the storage of documents in a case data unit, it necessarily fails to disclose the storage of any of these types of documents in a case data unit (or at all, for that matter).

Claim 22 recites "wherein storing the one or more documents comprises storing each document as part of a document entity that comprises the document and a set of meta-data about the document, and claim 23 recites different types of meta-data that may be stored. Kamarei fails to teach or suggest the elements of these claims as well.

Nor does Kamarei recite scanning a paper to produce a scanned document and storing the scanned document, as recited by claim 24. Necessarily then, Kamarei cannot teach the elements of claim 25, which recites "subjecting the scanned document to optical character recognition to recognize data from one or more fields from the scanned document; wherein storing the data related to the intellectual property case comprises storing the recognized data in the case data unit." Similarly, Kamarei fails to teach or suggest that a signal indicating occurrence of an event might be generated responsive to such recognized data, as recited by claim 26.

For at least these reasons, claims 21-26 are believed to be novel over Kamarei, and therefore are believed to be independently allowable. Further, claims 21-26, like claims 2, 5-10, 12-15 and 18-20, are believed to be allowable at least by virtue of their dependence from allowable base claims.

§ 103 Rejections

Claim 3 was rejected under § 103(a) as being unpatentable over Kamarei. As noted above, claim 1 is allowable over Kamarei, and claim 3 is believed to be allowable at least because it depends from allowable claim 1.

Conclusion

In view of the foregoing, Applicant believes all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

Date: July 18, 2006

/Chad E. King/
Chad E. King, Reg. No. 44,187

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, CA 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
CEK/jln
60732751 v1